



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,270	12/07/1999	BRUCE J. KOKKO	2130(FJ-99-1)	6225

7590 02/03/2003

MCHALE W FERRELL ESQ  
FERRELLS LLP  
P.O. BOX 312  
CLIFTON, VA 20124-1706

EXAMINER

ALVO, MARC S

ART UNIT	PAPER NUMBER
1731	17

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/456,270	KOKKO, BRUCE J.
	Examiner Steve Alvo	Art Unit 1731
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b>		
<b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>26 November 2002</u> .		
2a) <input checked="" type="checkbox"/> This action is <b>FINAL</b> .                            2b) <input type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-5,7-10,13-15,17-20,31-35 and 56-61</u> is/are pending in the application.		
4a) Of the above claim(s) <u>62-64</u> is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input type="checkbox"/> Claim(s) <u>1-5,7-10,13-15,17-20,31-35 and 56-61</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.		
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.		
If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).		
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:		
1. <input type="checkbox"/> Certified copies of the priority documents have been received.		
2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.		
3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).		
a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
<b>Attachment(s)</b>		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____.		

Applicant elected the claims drawn to the process of making an absorbent sheet and elected the species 1-(2-octadecenamidoethyl)-2-heptadecenyl-3-methylimidazolinium methyl sulfate as the quaternary ammonium surfactant and PEG dioleate as the non-ionic surfactant in Paper No. 5, such restriction is made Final. New claims 62-64 are not drawn to the elected species, 1-(2-octadecenamidoethyl)-2-heptadecenyl-3-methylimidazolinium methylsulfate and PEG dioleate, and are withdrawn from consideration.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7-10, 13-15, 17-20, 31-35, and 56-61 are rejected under 35 U.S.C. 103(a) as obvious over ADMITTED PRIOR ART (IDS filed 10-15-2001) in view of OSBORN '699 and BACK et al '681.

The ADMITTED PRIOR ART (Formulation A) teaches using the same quaternary ammonium surfactant and a very similar cationic surfactant used by Applicant to treat paper pulp with a debonding composition (Formulation A) to make an absorbent sheet. OSBORN '699 also teaches using quaternary ammonium surfactant and a nonionic surfactant to make absorbent sheet materials. OSBORN '699 teaches that the same amount of quaternary ammonium surfactant (column 4, lines 32-37) and nonionic surfactant (column 4, lines 63-66) can be used in the composition, e.g. 0.5 5.0 g/kg bone-dry fiber of each of the surfactants. It would have been

obvious to use the surfactants of the ADMITTED PRIOR art in the proportions taught by OSBORN '699. At best Applicant is optimizing the "debonding", "absorbency" and "softening" of the prior art. There is a reasonable expectation that the debonding of the prior art would yield a sheet material having the desired amount of "debonding", "absorbency" and "softening". *In re O'Farrel*, 7 USPQ2d 1673, 1680-81. In any event, it is well settled that an artisan with ordinary skill would have found it obvious to determine workable or even optimum values for an art recognized, result effective parameter, such as the proper amount of "debonding", "absorbency" and "softening", *In re Boasch*, 205 USPQ 215, 219; *In re Aller*, 105, USPQ 233, 235. OSBORN '699 also teaches (column 4, lines 41-66) the alternativeness of using various alkoxylated esters of a fatty acid as the nonionic surfactant. The use of the elected species, PEG dioleate, would have been obvious from the teachings of OSBORN '699. See OSBORN, III for using alkoxylated and ethoxylated fatty acids and alcohols, including PEG-9 oleate and PEG-4 dilaurate. The specific alkoxylated and ethoxylated fatty acids and alcohols appear to be commercially available. It would have been *prima facie* obvious to substitute one alkoxylated or ethoxylated fatty acid or alcohol surfactant for another. BACK et al teaches that absorbent sheets can be made from recycle paper, e.g. newspapers. It would have been obvious to the artisan to use the recycled wood pulp of BACK et al as the wood pulp of the ADMITTED PRIOR ART. This would have been especially obvious as the debonding composition (Formulation B) is promoted by its manufacturer as being "Best on virgin and mixed virgin/recycled", see IDS page 2, last paragraph. Clearly Formulation B can be used on recycled pulp.

The 11-25-2002 Declaration, of Dr. Bruce J. Kokko, has been considered. However, the Declaration does not compare the elected process to the closest prior art, e.g. formulation A. It would have been *prima facie* obvious to substitute one nonionic surfactant for another. The Declaration states that Formulation A, which is the closest Prior Art (a commercially available debonder composition), uses a PEG dioleate. This is the same PEG-oleate as the elected species. Applicant compares formulae A to formulation P that does not have a PEG-dioleate, but instead uses PEG-400-monooleate. Applicant states that Formulation P is the “of the Application. It is assumed Applicant is comparing the instant invention (Formula P) to the closest Prior Art (formula A). PEG-400-monooleate is not the elected species. The Examiner has not searched such a species. The broad claims read on the elected species, PEG-dioleate, and the 132 Declaration does not overcome the *prima facie* case of obviousness over Formulation A, the

**ADMITTED PRIOR ART.**

The 35 USC 112, paragraph 1 rejections have been dropped as Applicant has shown that all the terms were originally disclosed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

It is noted that the Amendment, both copies faxed to Office, is missing page 1. Page 1 should be supplied with the next response.

When filing an "Official" FAX in Group 1730, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file. The "Official" FAX phone numbers for this TC 1700 are:

Non-Final Fax: (703) 872-9310 After-Final FAX: (703) 872-9311

When filing an "Unofficial" FAX in Group 1730, please indicate in the Header (upper right) "Unofficial" for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers. The "Unofficial" FAX phone number for this Art Unit (1731) is (703) 305-7115.

Any inquiry concerning this communication or earlier communications from the primary examiner should be directed to Steve Alvo whose telephone number is (703) 308-2048. The Examiner can normally be reached on Monday - Friday from 6:00 AM - 2:30 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is (703) 308-0661.

The Customer Services Center for Technology Center 1700 (703-306-5665) shall provide the following service assistance to external and internal customers in the areas listed below.

Services provided:

Patent Application Filing Receipts

Missing References

Information regarding When Action can be Expected

Lost/Misplaced/Requested Application retrieval

Retrieval from PTO Publication Branch

Retrieval from non-Publication Branch

Status Queries (written or oral)

Paper Matching Queries

Certificates of Correction

Printer Waiting

The Customer Service Office, TC 1700, is located in CP3-8-D13, and is open to receive requests for service in person, by phone (703) 306-5665, or E-mail "Customer Service 1700" from 8:30 am-5:00 pm each business day. The Customer Services Center is part of the Special Programs Office of TC 1700 and will be staffed by the Technical Information Specialists who will serve as Customer Service Representatives (CSR).



STEVE ALVO  
PRIMARY EXAMINER  
ART UNIT 1731

MSA  
January 30, 2003